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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,586	12/12/2000	Tyler Peppel	OOMP0001C	7217

22862   7590   02/03/2003

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EXAMINER
LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/735,586	Applicant(s) PEPPEL, TYLER
	Examiner Benjamin E Lanier	Art Unit 2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-37_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-37_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _12 December 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   Applicant's preliminary amendment addition of claims 26-37 has been acknowledged.

Applicant's copied submitted declaration under 37 CFR § 1.131, from parent case 08/398,862, if

filed in this case would not provide sufficient evidence because the mention of the term "rare

card" in applicant's copied declaration does not show the possession of the concept of content

scarcity as a hidden portion of an electronic card or a time limit on the availability of an

electronic card as disclosed in the applicant's specification. Evidence is needed to support

applicant's disclosure.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after December 12, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.   Claims 1-7, 9, 10, 13-17, 19, 20, 22, 25-35, and 37 are rejected under 35 U.S.C. 102(e) as

being anticipated Smith, U.S. Patent No. 5,533,124. Referring to claims 1, 2, 5, 6, 9, 13, 14, 15,

19, 25-35, and 37, Smith discloses executable program code under the control of a

processor/controller (computer code segment embodied in tangible medium) (Col. 5, lines 31-

33), digital data (digital content) (Col. 5, line 51), software that causes trading card data that has

been stored to be cleared or deleted (supports content scarcity and content authenticity) (Col. 3,

lines 24-34), a copy protection scheme using encryption (lock and key mechanism) (Col. 2, lines

31-44), data for producing graphics, written text, sound, and video (graphic identification code

and multimedia) (Col. 2, lines 13-17), interactive areas used to provide different graphics and

multimedia (Col. 3, lines 13-15), and a PC (Col. 5, line12), trading card software (Col. 5, line

27), input devices (Col. 5, line 27), and a display (Col. 5, line 30).

Referring to claims 3 and 16, Smith discloses a system comprising RAM (Col. 2, line

52), hard disk (Col. 9, line 5), or other disk drive (Col. 8, line 64).

Referring to claims 4 and 17, Smith discloses a copy protection scheme where the trading

card data will be deleted after quitting the program (Col. 9, lines 19-22).

Referring to claim 10, Smith discloses data that could include any sports player as well as

any other individual or character that has become sufficiently famous (Col. 9, lines 23-26).

Referring to claim 22, Smith discloses data that is intended to be exchanged between

users onto removable media (Col.5, lines 54-59).

Referring to claims 7 and 20, Smith discloses individual data that is associated with a

certain player or character that can be packaged together (Col. 2, lines 10-13).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 9, 13, 33, 34, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by

Durst, U.S. Patent No. 5,022,080. Referring to claims 9, 13, 33, 34, and 37, Durst discloses an

electronic notary wherein a second unit of data is generated from a first unit of data, the second

unit of data being expressive of an information content of the first unit of data (generate

computer code segment expressing digital content). A time indication (time stamp, supports

content scarcity and content authenticity) is then generated for the second unit of data and then

the second unit of data and the time indication (time stamp) are encrypted (Abstract).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 8, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Smith, U.S. Patent No. 5,533,124, in view of Cooper, U.S. Patent No. 5,757,907. Referring to

claims 8, 18 and 21, Smith discloses executable program code under the control of a

processor/controller (computer code segment embodied in tangible medium) (Col. 5, lines 31-

33), digital data (digital content) (Col. 5, line 51), software that causes trading card data that has

been stored to be cleared or deleted (supports content scarcity and content authenticity) (Col. 3,

lines 24-34), a copy protection scheme using encryption (lock and key mechanism) (Col. 2, lines

31-44), data for producing graphics, written text, sound, and video (graphic identification code

and multimedia) (Col. 2, lines 13-17), interactive areas used to provide different graphics and multimedia (Col. 3, lines 13-15), and a PC (Col. 5, line12), trading card software (Col. 5, line 27), input devices (Col. 5, line 27), and a display (Col. 5, line 30). Shamir discloses using watermark for protecting visual information (Col. 1, line 45 – Col. 2, line 15). Smith does not disclose executable program code that has a trial mode or trial number of sessions. Cooper discloses program code that has a trial mode defined by either a timer, or a counter (Col. 8, lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a time trial on the executable program code of Smith in order to reduce unnecessary risks of piracy or unauthorized utilization beyond the trial interval as taught in Cooper (Col. 2, lines 26-31).

7.   Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, U.S. Patent No. 5,533,124, in view of Welsh, U.S. Patent No. 4,970,666. Smith discloses executable program code under the control of a processor/controller (computer code segment embodied in tangible medium) (Col. 5, lines 31-33), digital data (digital content) (Col. 5, line 51), software that causes trading card data that has been stored to be cleared or deleted (supports content scarcity and content authenticity) (Col. 3, lines 24-34), a copy protection scheme using encryption (lock and key mechanism) (Col. 2, lines 31-44), data for producing graphics, written text, sound, and video (graphic identification code and multimedia) (Col. 2, lines 13-17), interactive areas used to provide different graphics and multimedia (Col. 3, lines 13-15), and a PC (Col. 5, line12), trading card software (Col. 5, line 27), input devices (Col. 5, line 27), and a display (Col. 5, line 30). Shamir discloses using watermark for protecting visual information (Col. 1, line 45 – Col. 2, line 15). Smith does not disclose a digital content library or album of

computer code. Welsh discloses an image library containing a collection of images (Col. 3, lines 6-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the image library in the executable code system of Smith because the library would enable the user to select additional image elements from the image library as taught in Welsh (Col. 3, lines 6-19).

8.   Claims 23 and 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, U.S. Patent No. 5,533,124, in view of Lindsey, U.S. Patent No. 5,063,507. Referring to claims 23 and 36, Smith discloses executable program code under the control of a processor/controller (computer code segment embodied in tangible medium) (Col. 5, lines 31-33), digital data (digital content) (Col. 5, line 51), software that causes trading card data that has been stored to be cleared or deleted (supports content scarcity and content authenticity) (Col. 3, lines 24-34), a copy protection scheme using encryption (lock and key mechanism) (Col. 2, lines 31-44), data for producing graphics, written text, sound, and video (graphic identification code and multimedia) (Col. 2, lines 13-17), interactive areas used to provide different graphics and multimedia (Col. 3, lines 13-15), and a PC (Col. 5, line12), trading card software (Col. 5, line 27), input devices (Col. 5, line 27), and a display (Col. 5, line 30). Shamir discloses using watermark for protecting visual information (Col. 1, line 45 – Col. 2, line 15). Smith does not disclose exchanging of computer code segments online. Lindsey discloses a terminal that performs online transactions of information (Col. 9, lines 16-28). It would have been obvious to one of ordinary skill at the time the invention was made to enable the system of Smith to exchange computer code over the Internet in order to increase the speed of the overall trading and acquisition process as taught in Lindsey (Col. 2, lines 30-37).

9.   Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, U.S.

Patent No. 5,533,124, in view of Moen, U.S. Patent No. 5,592,537. Referring to claim 24, Smith

discloses executable program code under the control of a processor/controller (computer code

segment embodied in tangible medium) (Col. 5, lines 31-33), digital data (digital content) (Col.

5, line 51), software that causes trading card data that has been stored to be cleared or deleted

(supports content scarcity and content authenticity) (Col. 3, lines 24-34), a copy protection

scheme using encryption (lock and key mechanism) (Col. 2, lines 31-44), data for producing

graphics, written text, sound, and video (graphic identification code and multimedia) (Col. 2,

lines 13-17), interactive areas used to provide different graphics and multimedia (Col. 3, lines

13-15), and a PC (Col. 5, line12), trading card software (Col. 5, line 27), input devices (Col. 5,

line 27), and a display (Col. 5, line 30). Shamir discloses using watermark for protecting visual

information (Col. 1, line 45 – Col. 2, line 15). Smith does not disclose phone numbers within the

computer code. Moen discloses a telecommunication messaging service with built in phone

numbers to provide quick communication (Col. 3, lines 41-60). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to include phone numbers into

the program code of Smith in order to permit a phone messaging by a user to a phone number

included within the program code as taught in Moen (Col. 3, lines 41-60).

10.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
      A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11.   Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,200,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a system that implements the use of digital content.

12.   Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,200,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a system that implements the use of digital content.

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is (703)-305-7684. The examiner can normally be reached on M-Th from 7:30am to 5:00pm, F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703)-305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703)-746-7239, after final (703)-746-7238, or non-official/draft (703)-746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100